

REMARKS

Reconsideration of the pending application is respectfully requested in view of the foregoing amendments and the following remarks.

Status of the Application

Claims 1-11, 13 and 15-37 are currently pending. Of these, claims 2-6, 12, 14-18, 20-23 and 25-34 have been withdrawn, claims 1, 9 and 35 are amended, and claims 7, 19 and 24 are canceled without prejudice. As the amendments are fully supported by the application as filed, no new matter has been introduced into the application by way of these amendments.

Summary of the Office Action

The Office Action opens by acknowledging receipt of the foreign priority document. Subsequently, the Office Action confirms the election made in response to the election requirement set forth in the prior Office Action.

Turing to the substantive aspects of the Office Action, claims 1, 7, 8 and 35 are rejected under 35 U.S.C. § 102(b) as being anticipated by JP 59-157109 (Nishikawa).

Claims 1, 8, 9 and 13 are rejected under 35 U.S.C. § 102(b) as anticipated by EP 0 982 123 (Kunita).

Claims 10, 11 and 36 are rejected under 35 U.S.C. § 103(a) as obvious over Kunita in view of US Published Patent Application 2002/0058207 (Urano et al.)

Claim 19 is rejected under 35 U.S.C. § 103(a) as obvious over Kunita in view of Nishikawa.

Claim 24 is rejected under 35 U.S.C. § 103(a) as obvious over Kunita in view of Nishikawa and further in view of Urano et al.

Discussion

Reconsideration of the referenced application is respectfully requested in view of the foregoing amendments and the following remarks.

At the outset, Applicants note that claim 37 has not been rejected. Clarification from the Examiner of the status of this claim is respectfully requested.

In this response, Applicants have amended claim 1 by introducing the limitations of claim 7 therein. In addition, the limitations of claim 1 (as amended herein) are introduced into claim 9. The other amendments are made to provide a claim set which is consistent with the foregoing changes.

In view of the foregoing, wherein all of the claims include *inter alia* the limitations of (canceled) claim 7, Applicants submit that the anticipation rejection of claims 1, 8, 9 and 13 over Kunita is rendered moot. Moreover, the obviousness rejections of claims 10, 11 and 36 over Kunita in view of Urano et al. is also rendered moot in view of the aforesaid amendment of claims 1 and 9. The rejection of claims 19 and 24 are rendered moot in view of the cancellation, without prejudice, of these claims.

Turning to the rejection of claims 1, 7, 8 and 35 over Nishikawa, the Office Action appears to argue that Nishikawa discloses a resin comprising a phenolic, monomeric unit wherein the phenyl group has a substituent comprising an imide group as represented by the formula (I). In this formula, the Office Action contends that X is defined as a mono-unsaturated aliphatic group which forms in the imide group a cyclic or bicyclic aliphatic ring containing one unsaturated bound (*e.g.*, see the four structures mentioned in Nishikawa).

Applicants respectfully submit that claim 1 (and thus those claims dependent thereon, including claims 8 and 35) is not anticipated by Nishikawa. The argument in the Office Action appears to be that when the group X has the formula of a cyclohexyl group [see structure on page 3], the resin of formula (I) meets the limitation of claim 7 (now, of independent claims 1 and 9 as amended herein). As further described in the pending claims, in the polymer the imide group comprises an aromatic group, annelated on the cyclic group formed with the imide group. The Nishikawa disclosure is limited to a cyclic imide group which may be annelated with an aliphatic group having one unsaturated group. Applicants thus submit there is no disclosure of, or teaching in Nishikawa which would motivate one skilled in the art to provide, a cyclic imide annelated with an aromatic group as described in the pending claims.

In view of the foregoing, Applicants respectfully request withdrawal of the rejection over Nishikawa.

Conclusion

As Applicants believe the application is in proper condition for allowance, the examiner is respectfully requested to pass the application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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